

Applicant : Yang, et al
Appl. No. : 09/347,845
Examiner : Bui, Vy Q.
Docket No. : 702563.40

REMARKS

In the Office Action, the Examiner rejected claims 1, 3-4, 8-15, 17-22 and 24-25 under 35 U.S.C. 102(e) as anticipated by USP 6,193,747 to Von Oepen; rejected claims 2 and 23 under 35 U.S.C. 103(a) for obviousness over the Von Oepen patent in view of USP 6,224,626 to Steinke; and rejected claims 5-6 under 35 U.S.C. 103(a) for obviousness over the combination of the Von Oepen and Steinke patents, in further view of USP 5,824,054 to Khosravi. The Examiner stated that Applicant's amendment filed 4/08/2004 had been considered but that the claims were still rejectable as indicated in the present office action.

In response, Applicants have amended claims 1 and 12 to overcome the Examiner's rejections. As explained below, Applicant submits that the subject application is in condition for allowance, and earnestly requests both entry of the amendment and allowance of the claims.

Claim Rejections Under 35 U.S.C. 102(e)

The Examiner rejected claims 1, 3-4, 8-15, 17-22 and 24-25 under 35 U.S.C. 102(e) as being anticipated by von Oepen (USP 6,193,747). Turning first to the rejections of claims 1 and 12, these rejections were based upon the device illustrated in Figure 8 of the von Oepen patent. The Examiner identified a pair of "web patterns" (61 and 62) located in the central body of the device as corresponding to the "first end" and "second end" recited in Applicant's claim. (See Office Action, pg. 5). In response, Applicant has amended claims 1 and 12 to recite more clearly that the "first end" and "second end" refer to the cylindrical bands located at the opposite ends of the tubular body recited in those claims.

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Therefore, as recited in the amended claim 1, the “central portion consists essentially of” the non-sinusoidal cylindrical bands and non-sinusoidal longitudinal connectors that extend between the terminal cylindrical bands. In addition, as recited in amended claim 12, the “central portion consists essentially of” a plurality of bat-shaped cells formed from non-sinusoidal cylindrical bands and non-sinusoidal longitudinal connectors that extend between the terminal cylindrical bands.

As noted in Applicant’s previous response, the “consists essentially of” transition phrase indicates that the claim is partially open, i.e., that the invention includes the recited elements and is open to unlisted elements that do not materially affect the basic and novel properties of the invention. PPG Industries v. Guardian Industries Corp., 156 F.3d 1351, 1354 (Fed. Cir. 1998). A “consisting essentially of” claim occupies middle ground between closed claims that are written in a “consisting of” format and fully open claims that are drafted in a “comprising” format. Id. In particular, the present claims 1 and 12 exclude stents having a central portion that includes sinusoidal cylindrical bands or sinusoidal longitudinal connectors. Inclusion of such features would materially affect the properties of the claimed “non-sinusoidal” structures.

In contrast, the von Oepen patent discloses a stent having a sinusoidal web pattern connected by “spring elements” of several disclosed shapes. For example, the Examiner refers to the Figure 8 structure, which includes sinusoidal web patterns 61 and 62 separated by spring elements 64 and 65, all of which are located in the central portion of the von Oepen device. This structure, therefore, does not consist essentially of cylindrical

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bands comprising non-sinusoidal diagonal elements, nor does it consist essentially of generally bat-shaped cells formed from non-sinusoidal cylindrical bands.

The Examiner states in the Office Action, in reference to the von Oepen device illustrated in Figure 8: "Notice that the central portion consists essentially of a series of cylindrical bands because the central portion includes a majority of cylindrical bands." (Office Action, pg. 3). The Examiner also states: "The central portion consists essentially of a plurality of bat-shaped cells because there are a majority of bat-shaped cells in the central portion." These statements reflect an improper application of the "consists essentially of" transition phrase. The appropriate analysis is to determine whether the unrecited elements "materially affect the basic and novel properties" of the recited invention, not whether the recited elements constitute the "majority" of the reference relied upon. As noted above, the sinusoidal web patterns illustrated in the von Oepen device materially affect the properties of that device. Therefore, these devices do not anticipate the claims of the present application.

Moreover, in the current Office Action, the Examiner characterized the sinusoidal web pattern in the Von Oepen stent as a longitudinal connector. However, the Von Oepen web patterns cannot be "generally non-sinusoidal longitudinal connectors," as the presently amended claims recite. Nor do the present claims having the "consists essentially of" transition permit a construction that covers the Von Oepen stent structure.

Thus, each of claims 1 and 12 distinguishes over the stents shown in the von Oepen patent. Each of the other rejected claims is dependent on one or the other of claims 1 and 12, and each is therefore distinguished from von Oepen on the same basis.

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Accordingly, because each of the independent claims of the present application contains limitations not found in the von Oepen patent, the section 102(e) rejection is overcome and the claims are in condition for allowance.

Claim Rejections Under 35 U.S.C. 103(a)

The Examiner rejected claims 2, 5-6, and 23 under 35 U.S.C. 103(a) as being unpatentable over the von Oepen patent in view of Steinke (USP 6,224,626) (as to claims 2 and 23) and Khosravi et al. (USP 5,824,054) (as to claims 5-6). Because neither of the cited references, either alone or in combination, discloses, teaches, or suggests the subject matter of the claims as presently amended, reconsideration and withdrawal of the rejections is respectfully requested.

Specifically, the section 103 rejections are based upon the same analysis of the von Oepen patent addressed above in relation to the section 102(e) rejections. Accordingly, for the same reasons set forth above, the combination of the von Oepen, Steinke, and Khosravi et al. patents fail to disclose all of the limitations recited in the amended claims. The claims are, therefore, in condition for allowance.

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CONCLUSION

In view of the foregoing, it is submitted that the claims presented in this application define patentable subject matter over the cited prior art. Accordingly, Applicant respectfully requests entry of the amendments and allowance of the claims.

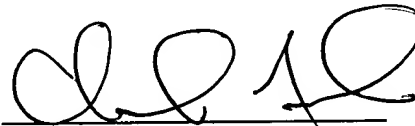
The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 15-0665.

Respectfully submitted,

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